

### **DETAILED ACTION**

Claims 1-8 and 11-14 are under consideration in this application.

Claims 9, 10 and 15-44 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

### ***Election/Restrictions***

Applicant's election without traverse of Group II and the compound of claim 2 in the reply filed on March 3, 2010 is acknowledged.

This application has been examined to the extent readable on the elected compounds of formula I wherein R<sub>1</sub> is (optionally substituted) benzyl, exclusively.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No support can be found for the compounds of formula II having a bromide.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 provides for the use of treating an IL-8 related condition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 12 is improper since it is a pharmaceutical composition comprising a compound of formula (II) and inert carrier. It is suggested that the use limitation be deleted to overcome this rejection.

The claims measure the invention. *United Carbon Co. V. Binney & Smith Co.*, 55 USPQ 381 at 384, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

The C.C.P.A. in 1978 held "that invention is the subject matter defined by the claims submitted by the applicant. We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim": In re Priest, 199 USPQ 11, at 15.

***Allowable Subject Matter***

Claim 1 is objected to as containing nonelected subject matter. The objection may be overcome by limiting the claim to the subject matter indicated as being examinable, supra. A claim so limited would appear allowable,

Claims 2-8 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if rewritten directed solely to the elected compounds.

Claim 11 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and if rewritten directed solely to the elected compounds.

Claims 12-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims and if limited to the elected compounds.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Patricia L. Morris/  
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